

REMARKS

Claims 4-19 are pending, but stand rejected under 35 U.S.C. § 102(b) because the Examiner believes that they are anticipated by U.S. Patent No. 5,689,828 issued to Mah (hereinafter "Mah"). Specifically, the Examiner believes that the limitation "the gelatinous cushion is thin enough to fit within a glove" is disclosed by Mah because Mah discloses "that there remains a need for a new form of glove [particularly] suited for wearing in conjunction with a baseball catching glove..." (See Mah at col. 1, lines 30-34). The Applicant respectfully disagrees with the Examiner and traverses the rejection.

A reference that merely discloses a "need" does not, therefore, automatically disclose an "inventive feature" that fulfills that "need." If a statement in the prior art that merely disclosed a "need" was deemed to disclose an "inventive feature" in a later patent application that fulfilled that "need," then all inventions, now matter how innovative, would be disclosed by a single sentence in the prior art that merely described a "need" for innovation. The Applicants respectfully believes that this erroneous line of reasoning is being applied here.


Mah merely discloses that there is a *need* for a new form of glove that is suited for wearing *in conjunction with* a baseball catching glove. Mah simply does not disclose *a gelatinous cushion that is thin enough to fit within a glove*. First, Mah does not disclose the requirement of "*a gelatinous cushion*." Second, Mah discloses only that a new form of glove should be worn *in conjunction with* a baseball catching glove, and does not disclose that the guard "*is thin enough to fit within*" a glove. According to the Examiner's reasoning, any newly designed guard, now matter how innovative, but so long as it fits within a glove, is not patentable simply because Mah discloses a need for a new glove that for wearing in conjunction with a catching glove.

The rejection also ignores the specifications teachings that a gelatinous cushion offers the advantages of being "light weight and comfortably conforms to the hand. It is thin enough to fit nicely within any standard glove, boxing or martial arts." (See page 3 of the Specification). The disclosure in Mah is far from describing such advantages offered by the claimed invention.

In light of the above arguments, the application is believed to be in condition for allowance. Accordingly, a Notice of Allowance is hereby solicited.

Respectfully submitted,

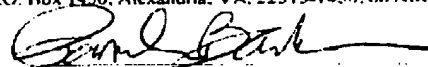
Dated: November 2, 2005

By: 
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being forwarded via facsimile to Examiner Andrew W. Sutton in Group No. 3765 at facsimile number (571) 273.8300 located at Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on November 2, 2005.

Date: November 2, 2005


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